

## **REMARKS/ARGUMENTS**

Claims 1-19 were previously pending. The present Amendment cancels claims 1-19 and adds new claims 20-34.

Applicants gratefully acknowledge that the Examiner's search indicated that the claimed method of staining bacteria using the elected species of compound 10 (Dye A), sulfamic acid as the nitrite ion reducing agent, tetradecyl trimethyl ammonium salt and citric acid-NaOH is free of the prior art found, and is therefore patentable. The Examiner subsequently expanded her search to the full scope of the claimed method as recited in claims 1-19. Claims 1-19 are cancelled by the present Amendment, and replaced by new claims 20-34. The new claims are directed to a method for discriminating bacteria contained in a urine sample. Support for independent claim 20 can be found on page 17, line 2 to page 18, line 13 of the present specification and claim 17. Claims 21 to 34 recite generally the same limitations as the now cancelled claims 2 to 19.

The Examiner objected to the length of the title of the present patent application. In response, the title has been amended to "Method of Discriminating Bacteria in Urine Sample," to clearly indicate the invention to which the claims are directed to. Claim 13 is objected to, and has been cancelled.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent 4,783,401 of Horan et al. Claims 1 and 2 are replaced by claims 20 and 21 by the present Amendment.

The Horan reference discloses a method for staining cells with cyanine dyes. In the examples of this reference, red blood cells and platelets in blood are stained with cyanine dyes. However, this reference is silent on a method for discriminating bacteria from other components

in the urine. The Horan reference does not disclose the preparation of an assay sample by mixing a urine sample and a first reagent comprising a cationic surfactant and a substance capable of reducing nitrite ions and mixing the obtained mixture and a second reagent comprising a polymethine dye, as recited in the present claim 20. Additionally, the Horan reference does not disclose “introducing the assay sample into a detecting part of a flow cytometer, irradiating the assay sample in the detecting part, and measuring scattered light and fluorescent light” or “discriminating the bacteria from other component based on the measured scattered light and fluorescent light,” as recited in the present claim 20.

Accordingly, Claim 20 is not anticipated by the Horan reference. Claim 21 is dependent on claim 20, and is likewise not anticipated by the Horan reference for the same reasons. It is respectfully requested that the rejection of claims 1 and 2, now claims 20 and 21, under 35 U.S.C. 102(b) as anticipated by U.S. Patent 4,783,401 of Horan et al. be withdrawn.

Claims 1-19 are rejected under 35 U.S.C. 102(a) as anticipated by EP 1136563 of Inoue et al. The Examiner states that the Inoue reference published September 26, 2001, after the Applicants’ foreign priority date of November 1, 2000. An English translation of Applicants’ priority document is submitted with the present Amendment to eliminate the Inoue reference as a prior art reference. Accordingly, it is respectfully requested that the rejection of claims 1-19 under 35 U.S.C. 102(a) as anticipated by EP 1136563 of Inoue et al. be withdrawn.

It is respectfully submitted that the pending claims 20-34 are now in a condition for allowance, notice of which is earnestly solicited.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,  
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